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Filing date: **02/07/2007**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91165809
Party	Plaintiff TriForest Enterprises, Inc. TriForest Enterprises, Inc. TriForest Enterprises, Inc. 17 Musick Irvine, CA 92618 UNITED STATES
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Date	02/07/2007
Attachments	Opposer's Reply Brief Signed mailed 2-7-07.pdf (11 pages)(1725856 bytes)

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In the matter of trademark application Serial No. 76/572,253
TTAB Opposition 91165809
For Plastic water bottle, sold empty, in IC 21
Published in the Official Gazette on (Date) 3/18/2005

TRIFOREST ENTERPRISES INCORPORATED
v.
NALGE NUNC INTERNATIONAL CORPORATION

OPPOSER'S REPLY BRIEF

Mail Stop TTAB
Assistant Commissioner for Trademarks
P.O. Box 1451
Alexandria, VA 22313-1451

Opposer:
TriForest Enterprises, Inc.
17 Musick
Irvine, CA 92618

Applicant:
Nalge Nunc International Corporation a Delaware Corp.
75 Panorama Creek Drive
Rochester, NY 14602-0365

The opposition is based on the following facts, previously stated and emphasized in this reply brief.

The Nalge trademark claim is both functional and commonplace. Nalgene manufactures Boston Round Bottles. They sell it in the life science market and in the outdoor market. The Boston Round Bottles are made of Polypropylene, Polyethylene, Polycarbonate or any other commonly and commercially available resin. Nalgene added a tether cap to the same bottles and began selling them with the application to prevent cap loss. The bottles were sold through the outdoor/camping distribution channels and marketed as so called "Nalgene Water Bottle". Customers who are in the lab market are

well aware that this is a Boston round bottle with several utility functions. Lab media suppliers use these bottles for the ease of labeling with an applicator, rolling cultures, and the simplicity of its design for packaging that has been established as "traditional lab bottles". Customers in the lab were first to purchase these bottles for hiking and outdoor activities when they realized it was Nalgene brand also. The customers now buy Nalgene brand bottles, because Nalgene is an established name brand in laboratory market as well as the consumer water bottle market. As a result many consumers know and purchase Nalgene hydration products that include other designs as well as the stated Boston Round.

Nalgene tries to confuse the issues by stating there are numerous choices of consumer water bottles, when the fact is a bottle is just that and the customers can use it for any liquid they choose to. The Boston round bottle is the most common bottle with many utility applications used in laboratory and life Science industry. Nalgene was not the first seller of the Boston Round Design. Nalgene was not the first to adopt a tethered cap. The same caps have been available with connector on water canteens since World War II as seen in the exhibits. The same polycarbonate bottle being claimed as a trademark is sold in the laboratory market as a media and reagent bottle. Nalgene's market position strategies place the bottles without a tether in the lab market as Boston round media bottles as seen on the Nalgene Labware page. These are the same bottles that are being marketed here with the same cap but no tether on the cap.

Nalgene also claims it has the trademark on the bottle neck design, US Trademark Registration #2,857,283 already being applied to this bottle. (Enclosed exhibit Nalgene Labware page). These are all functional design elements that they are now trying to

combine and trademark. For many small bottle manufacturers, defending claims of functional trademarks is extremely difficult and the costs of the legal system in defending against claims of functional trademarks supports a de facto monopoly. Nalgene files trademarks for expired patents (such as the square bottle D311,681) thus extending the design patent coverage indefinitely. They have filed for a trademark on the bottle groove and ring (Trademark 2857283), on the neck, and the arch on the shoulder (Trademark 2857279) of their square bottle. If customers look at each of these separately they will not know who the manufacturer is. In addition, Nalgene's trademark 2,857,283 consists of functional elements such as the groove for easy pouring and the ring for tamper evident shrink wrap. Trademark 2857279 is also a matter of basic geometry. The arch bottle shoulder is always created when a conical shape meets the straight wall. Nalgene received several trademarks on various functional elements in the past because no one opposed the trademark applications. However, this pattern cannot continue because a large number of functional trademarks creates an unfair and unintended burden on free competition.

Nalgene has successfully introduced other designs (refer to N-Gen) in the camping market. They have so many designs that consumers would not associate any particular design with the applicant. Because of the generic nature of the claimed trademark, TriForest is able to sell its Boston Round bottles to various markets including the lab market as well as the consumer and promotional products market. The Boston Round Bottle is commonly used in the lab market for roller-culturing and roller label applicator. TriForest also sells Boston Round Bottles with Tether caps in all its market without any distinction to the consumer. The tethered cap bottles are available in the lab

market, as well as in the consumer and promotional gift market. Therefore, the distinction between the different markets is not applicable. The buyers of TriForest products are filling the bottles with media, buffers, reagents for laboratory use and also for storing water, and other beverage in them. TriForest sends out the same bottles with tether cap as an option if they want to have a connected cap for their product or to use it without the tether cap. By providing a monopoly over the consumer products, promotional products and laboratory markets, the trademark office unfairly burdens free competition.

Nalgene has paid technical witnesses to add to the confusion of what is a consumer water bottle and what is not. None of the experts were asked if the same bottle was sold in the lab market. They would have to admit that there are the same water bottles in both markets. The fact is that the boston round is a simple design, the tether is a connection mechanism, and neither are novel inventions of Nalgene or special in any way. For the plastic resin, the Boston round bottle claimed is the simplest bottle to manufacture. Nalgene simply added color to its clear polycarbonate boston round lab bottles to enter the outdoors market. The same dimension bottles made with polypropylene, LDPE, HDPE and other resin are sold as boston round in Nalgene labware and Nalgene packaging catalogs.

From the record, the board can see that Nalgene has a history of informing it's distributors that its products are patented, and trademarked without explaining the difference in what specifically is protected. This creates a chilling effect on free competition and as a result, sellers, distributors, and marketers are deterred from dealing in a product that is really a public domain design. Nalgene has used this strategy with

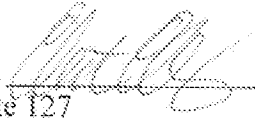
TriForest and its distributors by sending cease and desist letters, some of which have been attached as exhibits.

Nalgene is a large company that is trying to use its size to monopolize a functional public domain design. Just because a company is large and employing about a thousand people, does not mean that the goods it sells have automatically acquired secondary meaning. There is no presumption that large numbers of sales or employees automatically lead to secondary meaning covering every aspect of the product configuration, especially here because the claimed features are commonplace and functional. Nalgene itself has many other designs of water bottles that are not in dispute so it would be impossible to have customers associate every aspect of every design with the applicant. During the deposition of Margaret Gregory, there was a large number of exhibits and discussion about sales in general, but they are objectionable as not being relevant because they do not relate to the claimed features of the trademark.

The unfair monopoly granted by this trademark would prevent companies such as Triforest from selling a functionally equivalent product. Also, customers are likely to pay higher prices on a product that is public domain, and clearly has no difference in material (resin used) and the properties of the resin. During the deposition of Margaret Gregory on line 12- 19, pg. 8 she states that applicant has "very high recognition and market share". So customers look for the Nalgene word mark, which is an indicator of the quality of the goods. However, it does not follow that customers look for the commonplace Boston round design. The customers look for the Nalgene name and not for the design.

At this time, opposer does not plan to attend the oral argument proceedings. This is because the papers explain the opposer position and the applicant position in great detail. The points of emphasis that the opposer wanted to present were presented in this reply brief. Also, the opposer includes copies of exhibits in this reply brief showing the applicant's sales of the alleged trademark in the laboratory bottle market. These copies of exhibits are for emphasis that the applicant has no alleged trademark in the laboratory bottle market.

Respectfully submitted,

By Clement Cheng, Esq. 
17220 Newhope St., Suite 127
Fountain Valley, CA 92708
Phone: (714) 825-0555

Date: February 7th, 2007

Attorney for Opposer

PROOF OF SERVICE

In the matter of trademark application Serial No. 76/572,253

I, the undersigned, declare I am over the age of 18 and not a party to this action. My business address is at 17220 Newhope St., Suite 127 Fountain Valley, CA 92708.

On February 7th, 2007, I served:

OPPOSER'S TRIAL BRIEF

By placing true copies thereof in a sealed envelope, addressed as follows to:

1 copy sent to:

BRETT SCHATZ
WOOD, HERRON & EVANS, L.L.P.
2700 CAREW TOWER
441 VINE STREET
CINCINNATI, OH 45202-2917
ATTORNEY FOR APPLICANT

1 copy sent to:

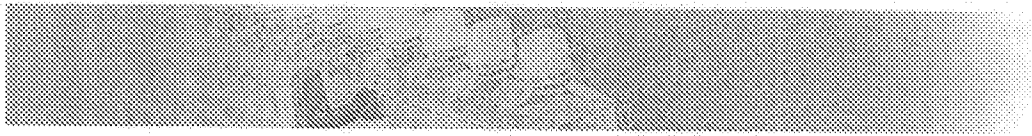
Mail Stop TTAB
Assistant Commissioner for Trademarks
P.O. Box 1451
Alexandria, VA 22313-1451

- ☐ **BY PERSONAL SERVICE:** I caused such envelope to be delivered by hand to the offices of the addressee(s).
- ☒ **BY MAIL:** I am readily familiar with the practice of the office for collection and processing of correspondence for mailing with the United States Postal Service. Under that practice, correspondence is put in the office outgoing mail tray for collection and is deposited in the U.S. Mail that same day in the ordinary course of business. I am aware that, on motion of the party served, service is presumed invalid if the postal cancellation date or postage meter date is more than one (1) day after the date of deposit for mailing shown on this proof of service.
- ☒ **FEDERAL:** I declare under penalty of perjury under the laws of the United States that the foregoing is true and that I am employed in the office of a member of the Bar of this Court at whose direction the service was made.
- ☐ **STATE:** I declare under penalty of perjury under the laws of the State of California that the foregoing is true and correct.

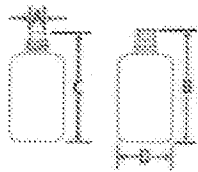
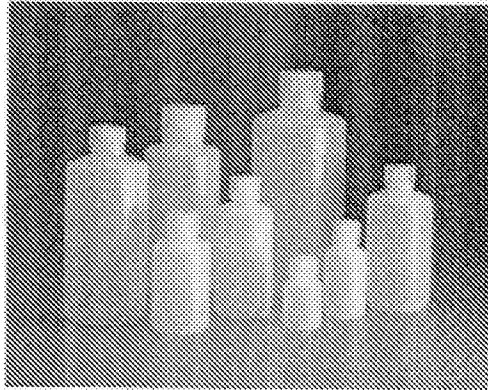
Executed on February 7th, 2007 at Fountain Valley, California.


signer

NALGENE® Packaging



312002 Narrow-Mouth Boston Round Bottles



NALGENE® Packaging

help

Part of Thermo Fisher Scientific

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Products

Technical Data

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CATALOG SEARCH

Catalog No.

Keyword Search

» improve a product

» new product idea

MY PROFILE

Email

Password

» forget your password

» create profile

» take site survey

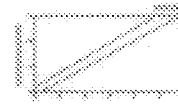
» take a site tour

Home » Products » Lab Quality Bottles

312002 Narrow-Mouth
Boston Round Bottles

Materials:

» HDPE with PP Closure



» view graph / diagram

» measured to a tolerance

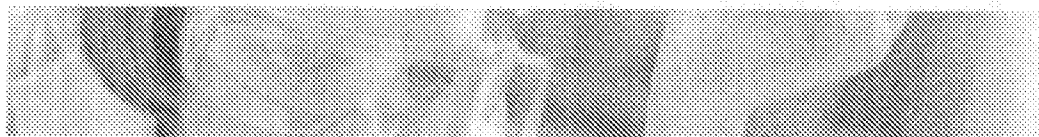
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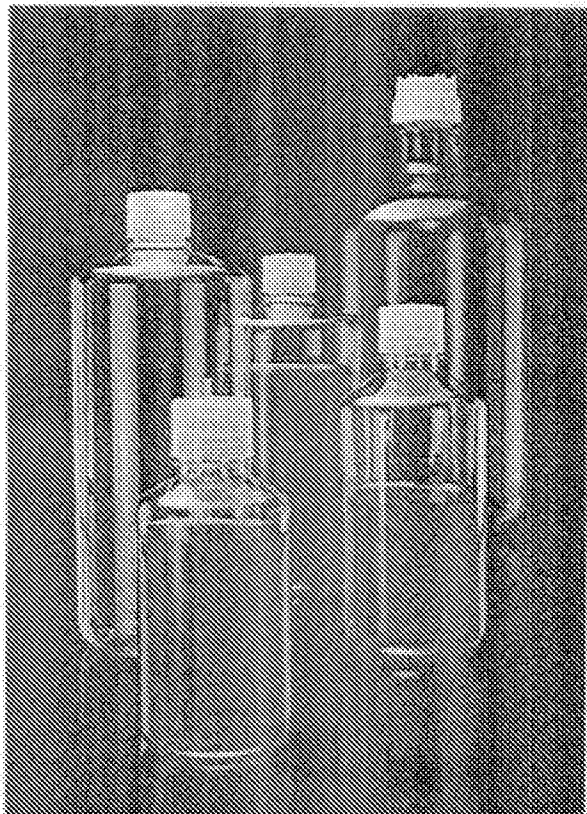
Cat. No.	Height, Cap., mm	Approx. Open Cap., mm	Height, Weight, g	Width	max A	max B	max C	max D
312002-0001	38	34	8	20-415	13	631	58	34
312002-0002	60	65	12	30-415	13	841	83	39
312002-0004	125	140	20	35-415	18	1021	95	51
312002-0006	175	200	33	24-415	18	124	123	63
312002-0008	250	285	32	28-415	18	1331	130	61
312002-0014	500	525	52	38-415	21	1700	168	79
312002-0016	500	525	58	38-430	27	170	168	74
312002-0032	1,000	1,040	100	38-430	27	2140	211	91

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NALGENE® Labware



2205, DS2205 Narrow-Mouth Bottles



CATALOG SEARCH

Catalog No.

Keyword Search

» improve a product

» new product idea

MY PROFILE

E-mail

Password

» forget your password

» create profile

» take the survey

» take a site tour

[Home](#) > [Products](#) > [Bottles](#)

2205, DS2205 Narrow-Mouth Bottles

Materials:

- Polycarbonate
- Polypropylene Screw Closure

Autoclavable, window-clear bottles with excellent impact resistance. Nalgene offers the widest selection of clear polycarbonate bottles from 500-ml to 20 liters. The 500- and 1000-ml sizes (Cat. Nos. 2205-0016 and 2205-0032) are good for smaller volume applications where you need to see your contents. The 2- and 2.5-liter sizes (Cat. Nos. 2205-0210 and 2205-0250) can be used as culture vessels for batch, suspension or non-attached roller-culturing. Contact R&D Technicalsupport for details. The 4- and 8-liter sizes (Cat. Nos. 2205-0010 and 2205-0020) have built-in shoulder loop for attaching an identification tag. NOTE: Before autoclaving, just set cap or closure on top of the container without engaging the threads. Autoclave empty. Repeated autoclaving will shorten the bottle life-span. Good for freezer use to -135°C.



» download a catalog

» print locally version



Cat. No.	2205-0016*	2205-0032*
Cap., ml	500 ml	1000 ml
Cap., oz.	16 oz.	32 oz.
Closure Size, mm	32-430	38-430
No. per Pkg	4	4
No. per Case	24	24

[Add to Cart](#)[Add to Cart](#)[Add to Cart](#)[Add to Cart](#)[Add to Cart](#)[Add to Cart](#)

Cat. No.	DS2205-0210*	DS2205-0250*	DS2205-0010*	DS2205-0020*
Cap., L	2	2.5	4	8
Cap., gal.	1/2	1/2	1	2
Closure Size, mm	38-430	38-430	38-430	538 (white)
No. per Case	1	1	1	1

*Bottle neck design is protected by US Trademark Reg. No. 2857283